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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,850	09/17/2001	Sridharan Rangarajan	2085-00100	1436
23505	7590	08/27/2004	EXAMINER	
CONLEY ROSE, P.C. P. O. BOX 3267 HOUSTON, TX 77253-3267			RUTTEN, JAMES D	
			ART UNIT	PAPER NUMBER
			2122	
DATE MAILED: 08/27/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/936,850

Applicant(s)

RANGARAJAN ET AL.

Examiner

J. Derek Rutten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/25/02
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the features canceled from the claims.

- Storing downloaded files and direction of file requests (claims 1, 7, and 13)
- Monitoring the number of times that files are requested or the particular files requested (claims 2 and 9)
- Requiring payments based on file requests (claim 2)
- Deleting downloaded files (claims 7 and 8)
- Identifying files for upgrade (claim 13)
- Upgrade intervals (claim 14)
- Download and operation of upgrade agent (claim 15)

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

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drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The specification is objected to for not complying with the arrangement of the application requirements of 37 CFR 1.77(b). See MPEP 608.01(a). For examination purposes, the "Background of the Invention" section has been determined to start on page 1 line 2, and end on page 3 line 29. The "Brief Summary" then starts on page 3 line 30, and ends on page 7 line 9, followed by the "Description of the Drawings" on page 7 lines 10-15, and further followed by the "Detailed Description" on page 7 line 16 through page 10 line 7.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 5, 13, 14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,960,204 to Yinger et al. (hereinafter "Yinger").

As per claim 1, Yinger discloses:

*A method of distributing software over a communication network (column 1 lines 49-52) including the steps of:*

*(a) making the software available on a file server attached to the network (column 1 lines 63-64: "Otherwise, if the desired application is available on a server computer...");*

*(b) providing and executing an installation application on a user's computer attached to the network (column 1 lines 59-60: "In response to a client computer receiving a request from a user to run an application...");*

*(c) monitoring file requests made by the installation application (column 1 lines 59-61: "...the client computer determines whether the application exists on the client computer.");*

*(d) identifying file requests which relate to files which are not present on the user's computer (column 1 lines 59-61 as cited above);*

*(e) downloading the identified files from the file server (column 1 lines 64-66: "the server computer automatically installs the application on the client computer");*

*(f) storing the downloaded files in storage media on the user's computer (column 1 lines 65-66: "installs the application on the client computer"); and*

*(g) directing the file requests for the identified files, and any future file requests for those files, to the downloaded versions of those files (column 1 lines 65-66 as cited above describes installing, which inherently directs requests to the installed files.).*

As per claim 5, the above rejection of claim 1 is incorporated. Yinger further discloses: *wherein the communication network is a local area network or a private wide area network (column 4 lines 4-9).*

As per claim 13, Yinger discloses:

*A method of automatically upgrading software on a user's computer over a communication network (column 1 lines 49-52) including the steps of:*

*(b) ascertaining that the software on the user's computer is an older version than the upgrade software (column 2 lines 1-5: "In an alternate embodiment of the present invention, if the application to be executed exists on the client computer, the client computer determines whether the application is the most recent version of the application available on the client/server system.");*

*(d) identifying file requests which relate to files which have been upgraded in the upgrade software (column 2 lines 5-9: "In response to the application not being the most recent version available, a server computer automatically installs an updated application on*

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the client computer, which then automatically executes the application after installation of the updated application.”);

All further limitations have been addressed in the above rejection of claim 1.

As per claim 14, the above rejection of claim 13 is incorporated. Yinger further discloses: *wherein the step of ascertaining that the software on the user's computer is an older version than the upgrade software occurs:*

*(i) each time the software on the user's computer is executed* (column 8 line 60 – column 9 line 15);

As per claim 17, the above rejection of claim 13 is incorporated. All further limitations have been addressed in the above rejection of claim 5.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yinger as applied to claim 1 above, and further in view of U.S. Patent 6,067,582 to Hewitt Smith et al. (hereinafter “Hewitt Smith”).



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As per claim 2, the above rejection of claim 1 is incorporated. Further, Yinger discloses: *(h) monitoring the particular files requested by the user's computer from the server* (column 1 lines 63-66). Yinger does not expressly disclose: *(i) requiring the owner of the user's computer to make payments based the particular files requested.*

However, in an analogous environment, Hewitt Smith teaches restricting access to software to paying customers (column 3 lines 20-23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Hewitt Smith's billing method in Yinger's software distribution system. One of ordinary skill would have been motivated to generate revenue for proprietary software.

7. Claims 3, 4, 6, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yinger as applied to claim 1 above, and further in view of "Computer User's Dictionary" by Microsoft Press (hereinafter "Microsoft").

As per claim 3, the above rejection of claim 1 is incorporated. Yinger does not expressly disclose a key entered during installation. However, in an analogous environment, Microsoft teaches the use of a "licensing key" entered during installation (page 209). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Microsoft's licensing key in Yinger's software distribution method. One of ordinary skill would have been motivated to reduce illegal use of software using a security device.

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As per claim 4, the above rejection of claim 1 is incorporated. Yinger does not expressly disclose *wherein the communication network is the Internet*. However, Microsoft teaches about a communication network known as the Internet (page 190). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Internet as taught by Microsoft in Yinger's software distribution method. One of ordinary skill would have been motivated to provide access to a worldwide collection of networks and gateways.

As per claim 6, the above rejection of claim 1 is incorporated. Yinger does not expressly disclose: *wherein the file server is: (i) an FTP server; (ii) an HTTP server; or (iii) a Gopher server*. However, in an analogous environment, Microsoft teaches the use of ftp, http and gopher servers for use on the Internet (page 190 "Internet"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Internet services as taught by Microsoft in Yinger's software distribution method. One of ordinary skill would have been motivated to provide support for a variety of file distribution protocols to ensure access by all users.

As per claims 16 and 18, the above rejection of claim 13 is incorporated. All further limitations have been addressed in the above rejections of claims 4 and 6, respectively.

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8. Claims 7-9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yinger in view of U.S. Patent 6,006,034 to Heath et al. (hereinafter "Heath").

As per claim 7, Yinger discloses: *A method of executing computer application software on a user's computer which is connected to a communication network* (column 1 lines 49-52). Yinger does not expressly disclose: *(h) deleting one or more of the downloaded files from the user's computer.* All further limitations have been addressed in the above rejection of claim 1.

However, in an analogous environment, Heath teaches deleting a file (column 3 lines 15-20: "The catalog file can also be specified to include a procedure to delete the components following the execution of the updated application program to free up disk space on the client."). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Heath's file deletion on Yinger's downloaded files. One of ordinary skill would have been motivated to free up disk space on a client computer.

As per claim 8, the above rejection of claim 7 is incorporated. Yinger does not expressly disclose: *wherein the step of deleting one or more of the downloaded files is done: (i) as the files are closed by the software; (ii) when execution of the software terminates; (iii) after a pre-determined time or number of days has elapsed; and/or (iii) after the software has been executed a pre-determined number of times.*

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However, Heath teaches deleting a file after execution terminates (column 3 lines 15-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Heath's method of deleting after execution termination on Yinger's downloaded files. One of ordinary skill would have been motivated to allow a program to execute before deleting it.

As per claims 9 and 11, the above rejection of claim 7 is incorporated. All further limitations have been addressed in the above rejections of claims 2 and 5, respectively.

9. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yinger and Heath as applied to claim 7 above, and further in view of Microsoft.

As per claims 10 and 12 the above rejection of claim 7 is incorporated. All further limitations have been addressed in the above rejections of claims 4 and 6, respectively.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yinger as applied to claim 13 above, and further in view of U.S. Patent 6,418,555 to Mohammed (hereinafter Mohammed).

As per claim 15, the above rejection of claim 13 is incorporated. Yinger does not expressly disclose: *an upgrade agent is downloaded from the file server to the user's*

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*computer and the upgrade agent performs the function of monitoring file requests made by the software to identify file requests which relate to files which have been upgraded in the upgrade software.*

However, in an analogous environment, Mohammed teaches the use of an upgrade module to perform upgrade operations if an upgrade is detected (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Mohammed's upgrade module to monitor upgraded file requests in Yinger's upgrade method. One of ordinary skill would have been motivated to distinguish files that need updating from files that haven't been updated in order to reduce bandwidth consumption and download time.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (703) 605-5233. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jdr

A handwritten signature in black ink, appearing to read "Antony Nguyen-Ba", written in a cursive style.

**ANTONY NGUYEN-BA  
PRIMARY EXAMINER**